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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re application of ) Group Art Unit: 2854  
Martin BECKER et al. ) Examiner: Yuan L. Chen  
Application No. 10/533,437 )  
Filed August 23, 2006 )  
For: ROTATING BODIES OF A )  
PRINTING PRESS )  
COMPRISING A BARREL )

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement of July 2, 2008 in the subject U.S. patent application, applicants elect to prosecute the invention or group of inventions identified by the Examiner as Group 26, claims 69 and 72 directed to a rotating body of a printing press including a barrel with a temperature control medium flow channel which is formed in a thermal insulating material including a member guide surface. Applicants expressly reserve the right to file one or more divisional patent applications directed to the inventions or groups of inventions not selected for prosecution in the subject U.S. patent application. This election is made with traverse.

In the Restriction Requirement, the Examiner based his decision on PCT Rule 13.1 and his assertion that the citation of a reference referred to as D1 showed that the

claims of Groups 1-61 do not directly relate to a single general inventive concept. The undersigned respectively disagrees.

It is to be noted that the International Preliminary Examination Report, which was mailed in the corresponding PCT application on February 26, 2005, is directed to claims 1-65. The IPER indicated that all of these claims met the requirements for both novelty and inventive activity. The recited D1 reference was relied on to support the position that all of the characteristics of the four independent claims in the PCT application were recited in the preambles of those claims, as is conventional in PCT practice. The finding, by the Examiner in the PCT application, that all of the claims pending in that application met the requirements of novelty and inventive activity is a very clear indication that the D1 reference did not establish a lack of unity *a posteriori* in the independent claims 1, 36 and 37 of PCT/DE03/03527. What it did indicate was that the preambles of all of these claims recited the features of the closest prior art.

In the PCT application, the Examiner noted that claims 1-35 and 39-50 were directed to one inventive concept; that claims 36 and 39-50 were directed to a second inventive concept and that claims 37, 38 and 51-65 were directed to a third inventive concept. Accordingly, it would not be unreasonable, in the present application, for the Examiner to require an election between the claims based on independent claim 66, the claims based on independent claim 69 and the claims based on independent claim 102.

For the Examiner to incorrectly assert that there are 61 separate inventions or groups of inventions overlooks the spirit and intent of PCT Rules 13.1 and 13.2. The Examiner's references to the citation of reference D1 as establishing a lack of unity *a posteriori* is not correct because the D1 reference was cited only to show that all of the

features of the claimed prior art were recited in the preambles of the independent claims. Since all of the claims in the PCT application were held to have both novelty and inventive activity, that is clear evidence that the D1 reference did not render any of the claims unpatentable. The Examiner's reasoning in the subject application is flawed. A restriction requirement that is more in agreement with the one set forth in the PCT application is requested.

Respectfully submitted,

Martin BECKER et al.  
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